

Application No.: 09/611,955

Docket No.: 20136-00318-US

Docket No.: F19-97-205US2

(20136-00318-US)

(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Cyprian E. Uzoh et al.

Application No.: 09/611,955

Confirmation No.: 6678

Filed: July 6, 2000

Art Unit: 2818

For: METHOD TO SELECTIVELY FILL  
RECESSES WITH CONDUCTIVE METAL

Examiner: H. K. Vu

**PETITION TO THE COMMISSIONER UNDER 37 C.F.R. 1.181**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Petition to the Commissioner is in response to the Communication dated April 7, 2004.

**Statement of Facts**

In the Final Rejection, the Examiner objected to the Specification as containing new matter and rejected claims 25 and 31-32 as containing new matter in the recitation "recesses located in at least one major surface of said semiconductor substrate." These issues were addressed by Applicants in the Appeal Brief filed November 25, 2003.

The Examiner then issued the communication dated April 7, 2004 that stated the Appeal Brief was improper because it addressed the above objections in addition to the other rejections of the claims and that these objections were petitionable not appealable. Also in that communication, the Examiner objected to the drawings under 37 C.F.R. §1.83(a).

Concerning the objection to the drawings, attached are copies of the amended drawings filed on July 31, 2003 in response to the Office Action dated May 29, 2003. These drawings

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illustrate insulation layer 3 located over at least one major surface of substrate 13 and in recesses in the substrate 13. Accordingly, new drawings are not deemed necessary.

In response to the objection to the specification and claims in reciting new matter, a Reply Brief has been filed pointing out why these objections are actually appealable. In addition, as discussed below, in the event these matters are not deemed appealable, it is requested that the Commissioner review these objections and find that the amendments to the specifications and claims did not introduce any new matter.

#### **Points to Review**

Do claims 25 and 31-32 and the specification contain new matter in the recitation “recess located in at least one major surface of said semiconductor substrate”?

#### **Action Requested**

The specification was objected as containing new matter under 35 U.S.C. §132 and claims 25 and 31-32 were objected to in the recitation “recesses located in at least one major surface of said semiconductor substrate.”

The objection to the specification as containing new matter and the objection to claims 25 and 31-32 are not deemed tenable. The specification as originally filed explicitly discloses that recesses are formed in at least one major surface of the semiconductor substrate. For instance see page 1, lines 14-16 of the original disclosure that state:

This is achieved by selectively plating recesses in a semiconductor substrate with conductive metal such as copper or gold.

Also, see original claim 25 as filed which states “recesses located in at least one major surface of said semiconductor substrate.” In addition, see the original Abstract of the Disclosure that states:

Recesses in a semiconductor structure are selectively plated...

Accordingly, the above recitation is not new matter and claims 25 and 32 properly recite “in”.

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The mere filing of proposed amended drawings, dated July 16, 2002 does not detract from the original disclosure and what is taught therein. The proposed drawings filed subsequent to the original filing of the application is not sufficient basis to conclude the presence of new matter. It seems implausible to rely more heavily upon material presented after filing than on originally disclosed subject matter.

**Conclusion**

In view of the above, it is abundantly clear that the Primary Examiner has erred in concluding that the specification and claims 25 and 31-32 contain new matter. It is therefore, requested that the Commissioner find that the specification and claims do not contain new matter. It is also requested, as discussed, that the Commissioner determine that new amended drawings are not required.

The Commissioner is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to Deposit Account No. 09-0458, under Order No. 20136-00318-US from which the undersigned is authorized to draw.

Dated: 6-3-04

Respectfully submitted,

By 

Burton A. Altermann

Registration No.: 24,852

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorney for Applicant